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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/758,852 | 01/11/2001 | Shigeru Imura | 7217/63438 | 9783 |

7590 06/07/2004
JAY H. MAIOLI
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EXAMINER

IQBAL, KHAWAR

| ART UNIT | PAPER NUMBER |
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2686

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,852

Applicant(s)

IMURA, SHIGERU

Examiner

Khawar Iqbal

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,11,12 and 15- 17 is/are rejected.
- 7) ☒ Claim(s) 2-3,7-10,13-14,18-21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities: The use of "loading/unloading" makes the claim indefinite since the slash mark means either "and" or "or". Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1,6,11,12,17 are rejected under 35 U.S.C. 102(e) as being unpatentable by Desblance et al (6456859).
2. Regarding claim 1 Desblance et al teaches a portable terminal (fig. 1 element 1), comprising:
 - display (2) means having a display screen (2);
 - input operation (7) means for being operated by a user of said portable terminal to input an operation input (keypad 7, col.), line 3);
 - storage means for storing information to be displayed on said display screen (col. 3, lines 18-22);

display control means for reading out information to be used to display on said display screen from said storage means in response to the operation input from said input operation means and controlling said display means to make a display corresponding to the operation input on the display screen based on the read out information from storage means (col. 3, lines 30-43);

Loading/unloading detection means for detecting loading or unloading of an external storage medium into or from said portable terminal (col. 3, lines 30-43);

authentication means operable when loading of an external storage medium is detected by said loading/unloading detection means for authenticating the external storage medium based on authentication information read out from the loaded external storage medium (col. 2, lines 49-60);

readout means operable when the authentication by said authentication means results in success for reading out data stored in the loaded external storage medium; and write means for writing the data read out by said readout means into said storage means (col. 2, lines 55-65).

Regarding claim 6 Desblance et al teaches updating means operable when the authentication of the loaded external storage medium by said authentication means results in success for updating the stored contents of the external storage medium with updating information acquired over a communication circuit (col. 3, lines 31-43).

Regarding claim 11 Desblance et al teaches wherein the external storage medium and said portable terminal have a one-by-one verification code, and said

authentication means verifies the verification codes of said portable terminal and an external storage medium loaded in said portable terminal (col. 3, lines 25-29).

Regarding claim 12 Desblance et al teaches a displaying information management method for a portable terminal for managing stored information of storage means of said portable terminal such that information to be used to display on a display screen is read out from said storage means in response to an operation input through input operation means and display is made on said display screen based on the read out

information in response to the operation input, comprising:

a preparation step of preparing an external storage medium (3) in which a plurality of pieces of information are stored as information to be displayed on said display screen (col. 3, lines 37-43);

an authentication step of authenticating, when loading of the external storage medium is detected by said portable terminal, the external storage medium based on authentication information read out from the external storage medium (col. 2, lines 47-65);

a readout step of reading out, when the authentication in the authentication step results in success, data stored in the loaded external storage medium; and a write step of writing the data read out in the readout step into said storage means (col. 2, lines 47-65, col. 3, lines 31-43).

Regarding claim 17 Desblance et al teaches wherein said portable terminal is a portable communication terminal (1), and said displaying (2) information management

method further comprises an updating step of updating, when the authentication of the loaded external storage medium in the authentication step results in success, the stored contents of the external storage medium with updating information acquired over a communication circuit (col. 3, lines 31-43).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4,5,15,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desblance et al (6456859) and further in view of Jouin et al (5778321).

5. Regarding claims 4,15 Desblance et al teaches the identification module (3) is an insertable card with a chip. The card has an integrated circuit (8) and a memory (4). The identification module slots into the side of the mobile telephone forming an interface (28) with the mobile phone processor. The card provides supplementary functions including display of the user telephone number in the screen, a repeat message facility, recognition of the user PIN and subscriber identification. Desblance et al does not specifically teach warning means for issuing a warning when the authentication by said authentication means results in failure.

In an analogous art, Jouin et al teaches warning means for issuing a warning when the authentication by said authentication means results in failure (col. 2, lines 34-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time

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the invention was made to modify the device of Desblance et al by specifically adding feature issuing a warning in order to enhance system performance in the present environment to identify the database as the functionality Improves the authentication as taught by Jouin et al.

Regarding claims 5,16 Desblance et al teaches the identification module (3) is an insertable card with a chip. The card has an integrated circuit (8) and a memory (4). The identification module slots into the side of the mobile telephone forming an interface (28) with the mobile phone processor. The card provides supplementary functions including display of the user telephone number in the screen, a repeat message facility, recognition of the user PIN and subscriber identification. Desblance et al does not specifically teach determined in advance for reporting the failure of the authentication to a reporting destination set in advance through said radio communication means.

In an analogous art, Jouin et al teaches determined in advance for reporting the failure of the authentication to a reporting destination set in advance through said radio communication means (col. 2, lines 34-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Desblance et al by specifically adding feature reporting the failure of the authentication in order to enhance system performance in the present environment to identify the database as the functionality Improves the authentication as taught by Jouin et al.

Allowable Subject Matter

6. Claims 2-3,7-10,13-14,18-21 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHAWAR IQBAL whose telephone number is 703-306-3015.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **BANKS-HAROLD, MARSHA**, can be reached at 703-305-4379.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231


or faxed to:

(703) 872-9314 (for Technology Center 2684 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Khawar Iqbal


CHARLES APPIAH
PRIMARY EXAMINER